

REMARKS

The Examiner requests a listing of related co-pending applications and patents.

Applicant is aware of the following co-pending applications and patents having a similar disclosure:

1. Application Serial No. 09/026,086
Now U.S. Patent No. 6,006,755
2. Application Serial No. 09/410,448
Now U.S. Patent No. 6,405,732
3. Application Serial No. 10/156,505
Filed: 28 May 2002
Title: Method to Treat Gastric Reflux Via the Detection and Ablation of Gastro-
Esophageal Nerves and Receptors
Examiner: Peffley, Michael F.
4. Application Serial No. 09/026,316
Now U.S. Patent No. 6,056,744
5. Application Serial No. 09/026,296
Now U.S. Patent No. 6,009,877
6. Application Serial No. 10/405,746
Filed: 2 April 2003
Title: Sphincter Treatment Apparatus
Examiner: Unknown

The Applicant notes the following related applications:

1. Application Serial No. 10/084,590
Now U.S. Patent No. 6,589,238
2. Application Serial No. 09/036,091
Now U.S. Patent No. 6,092,528
3. Application Serial No. 09/235,060
Now U.S. Patent No. 6,254,598
4. Application Serial No. 09/304,784
Now U.S. Patent No. 6,440,128
5. Application Serial No. 09/304,737
Now U.S. Patent No. 6,464,697
6. Application Serial No. 10/046,637
Now U.S. Patent No. 6,652,034
7. Application Serial No. 09/032,367
Now U.S. Patent No. 6,044,846
8. Application Serial No. 09/304,750
Now U.S. Patent No. 6,402,744
9. Application Serial No. 09/304,733
Now U.S. Patent No. 6,355,031
10. Application Serial No. 09/476,537
Now U.S. Patent No. 6,547,776
11. Application Serial No. 09/304,773
Now U.S. Patent No. 6,258,087
12. Application Serial No. 09/304,743
Now U.S. Patent No. 6,325,798
13. Application Serial No. 09/304,770
Now U.S. Patent No. 6,423,058
14. Application Serial No. 09/524,432
Now U.S. Patent No. 6,544,226

15. Application Serial No. 09/556,169
Filed: 21 April 2000
16. Title: Systems and Methods for Treating Dysfunctions in the Intestines and Rectum
Examiner: Vrettakos, Peter J
17. Application Serial No. 09/921,356
Filed: 2 August 2001
Title: Apparatus to Treat Esophageal Sphincters
Examiner: Peffley, Michael F.
18. Application Serial No. 09/073,467
Filed: 9 October 2001
Title: Method for Treating a Sphincter
Examiner: Peffley, Michael F.
19. Application Serial No. 09/955,915
Filed: 19 October 2001
Title: Devices, Systems and Methods for Treating Tissue Regions of the Body
Examiner: Ruddy, David M.
20. Application Serial No. 09/776,140
Filed: 2 February 2001
Title: Sphincter Treatment Apparatus
Examiner: Peffley, Michael F.
21. Application Serial No. 10/428,458
Filed: 2 May 2003
Title: GERD Treatment and Apparatus
Examiner: Unknown
22. Application Serial No. 10/230,655
Filed: 29 August 2002
Title: GERD Treatment Apparatus and Method
Examiner: Unknown

23. Application Serial No. 09/911,874
Filed: 24 July 2001
Title: GERD Treatment and Apparatus and Method
Examiner: Peffley, Michael F.
24. Application Serial No. 09/971,085
Filed: 4 October 2001
Title: Apparatus to Treat Esophageal Sphincters
Examiner: Peffley, Michael F.
25. Application Serial No. 10/254,471
Filed: 25 September 2002
Title: Method for Treating a Sphincter
Examiner: Unknown
26. Application Serial No. 10/155,294
Filed: 24 May 2002
Title: Systems and Methods for Forming Composite Lesions to Treat Dysfunction
in Sphincters and Adjoining Tissue Regions
Examiner: Peffley, Michael F.
27. Application Serial No. 10/017,906
Filed: 14 December 2001
Title: Systems and Methods Employing a Guidewire for Positioning and Stabilizing
External Instruments Deployed Within the Body
Examiner: Unknown

Claim 114 has been canceled.

Claims 107-113 remain pending in the application. Of these, claims 111-113 are currently amended.

Claims 111-114 are rejected under 35 U.S.C. §101. Claim 111 has been amended to eliminate positive recitation of the connection of the device to tissue and thereby overcome this rejection.

Claims 111-114 are rejected under 35 U.S.C. §112, first and second paragraphs.

Claim 111 has been amended to place it in method claim format to overcome these rejections.

Claims 107-114 are rejected under the doctrine of obviousness-type double patenting over the following patents:

1. Claims 1-88 of U.S. Patent No. 6,056,744
2. Claims 27-52 of U.S. Patent No. 6,077,257
3. Claims 1-51 of U.S. Patent No. 6,254,598
4. Claims 1-21 of U.S. Patent No. 6,258,087
5. Claims 1-16 of U.S. Patent No. 6,402,744

Claims 107-114 are provisionally rejected under the doctrine of obviousness-type double patenting over the pending claims of the following co-pending applications:

1. Application Serial No. 09/766,140 (the '140 Application)
2. Application Serial No. 09/921,356, now U.S. Patent No. 6,613,047
3. Application Serial No. 09/943,646 (the '646 Application)

Applicant notes that this application has been abandoned in favor of continuation Application Serial No. 10/405,746 (the '746 Application), filed April 2, 2003, Examiner unknown. A copy of the claims of the '746 Application as currently pending is attached (Attachment A).

4. Application Serial No. 09/911,874 (the '874 Application)
5. Application Serial No. 09/971,085 (the '085 Application)

With respect to all of the double patenting rejections and provisional double patenting rejections, the Examiner indicates that the "the use of mapping electrodes to first detect tissue is deemed an obvious consideration for one of ordinary skill in the art, particularly in view of the Edwards disclosure." Applicant respectfully disagrees. MPEP §804(II)(B)(2) requires a side by

side comparison of the claims of the instant application and the claims of the cited patents and applications, keeping in mind that only the claims of the cited patents and applications can be considered as support for the rejection, and the disclosures of these references are looked to only to determine the meaning of the claims. Here, the Examiner relies on the Edwards disclosure in support of the rejection. None of the cited claims or their accompanying disclosures teach or suggest mapping tissue at or near a sphincter. Although mapping tissue in other body regions may be known in the art, e.g., cardiac tissue, Applicant does not believe that either the possibility or the desirability of mapping electrical action potential in a tissue region at or near a sphincter would be known to or an obvious consideration for one of ordinary skill in the art, absent reliance on the disclosure of the cited references. Again, the Examiner has relied only the disclosure of Edwards in support of asserting that mapping tissue at or near a sphincter would be obvious to one skilled in the art. Applicant respectfully requests that these double patenting and provisional double patenting rejections be withdrawn.

Applicant also believes that the Examiner's request for terminal disclaimers based on the pending claims of several co-pending applications is premature, as the claims of the co-pending applications may subsequently be amended. As these are provisional rejections, Applicant requests that any double patenting issues with respect to the '140, '646, '746, '874, or '085 Applications and the instant Application be addressed upon the issue of one case and the indication of allowable subject matter in the other case.

Reconsideration in view of the foregoing amendments and remarks and allowance of claims 107-113 is respectfully requested.

Respectfully Submitted,

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